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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,723	11/07/2005	Andreas Smolarek	HEU-003US	2043
959 7590 01/30/2009 LAHIVE & COCKFIELD, LLP FLOOR 30, SUITE 3000 ONE POST OFFICE SQUARE BOSTON, MA 02109			EXAMINER DEFRANK, JOSEPH S	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 01/30/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/555,723	<b>Applicant(s)</b> SMOLAREK, ANDREAS	
	<b>Examiner</b> JOSEPH DEFRANK	<b>Art Unit</b> 3724	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date: _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/7/05; 2/6/06; 11/18/08</u>                                 | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of group II (claims 2-10) in the reply filed on 11/14/08 is acknowledged.
2. Claims 1 and 11-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/14/08.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

4. The disclosure is objected to because of the following informalities: the specification states, "the invention by a method and device for the breaking separation of bearing assemblies comprising the features of independent claims 1 and 2." This is not proper as claims 1 and 2 are changing (they have already been modified with a preliminary amendment). Do not refer to specific claims in the specification as the claims are subject to change.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 4, 5, 7, and 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 4, 5, and 7 recites the limitation "said at least one recess". There is insufficient antecedent basis for this limitation in the claim. Examiner notes it is unclear if this is supposed to be "an at least one recess" or if these claims are intended to depend on claim 3 where the recess is first introduced because the claim dependency was amended in a preliminary amendment. For the purpose of examination, the limitations will be interpreted as "an at least one recess". Examiner further notes that claim 5 recites the limitation "said insertion slots" which lacks antecedent basis. The limitation will be interpreted as "insertion slots".

8. With respect to claim 10, it is unclear what the applicant is claiming. Is the applicant claiming a device for breaking bearing caps or an engine case comprising a crankshaft for a reciprocating piston engine? Based on all the other claims in the apparatus group, the applicant is claiming the device, not the engine.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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10. Claims 1-8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hahnel et al. (US 2004/0011842; hereafter Hahnel).

11. With respect to claim 2, Hahnel discloses a device configured to perform breaking separation of at least one bearing cap (4) from a corresponding thrust block in a bearing assembly an engine case provided with bearing bores (6) arranged in-line (along axis A), comprising an extension mandrel (18) insertable into at least one of said bearing bores (see figure 1) and said extension mandrel has two half-mandrels(18.2, 18.4), an expander (26) for moving said half-mandrels apart, said expander taking effect between said half-mandrels, at least two gripping means (14; there are 6), said gripping means being couple-able to said half-mandrel (see figure 1) corresponding to said at least one bearing cap, and a fixing means (16) connected to said at least two gripping means, wherein said at least one bearing cap being clampable between said corresponding half-mandrel and said fixing means and a unit comprising said corresponding half-mandrel, said gripping means, said fixing means and said clamped bearing cap is supported in a freely movable manner to a limited degree, though secured against rotation, in the direction of breaking separation.

12. With respect to claim 3, Hahnel discloses the device wherein said half-mandrel corresponding to said bearing cap comprises at least one recess (section 22 forms a recess) engageable with said gripping means (14).

13. With respect to claim 4, Hahnel discloses the device wherein said half-mandrel corresponding to said bearing cap comprises, at its periphery on mutually facing sides, tangentially extending insertion slots (gaps formed between sections 24) for said

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gripping means, said slots being in communication with said at least one recess (the slots are "in communication" with the recess for actuator 26 because they are mounted on the same device)..

14. With respect to claim 5, Hahnel discloses the device wherein at least one recess (the final space after the furthest left raised section 24 on figure 2; between 20 and 24), when viewed in an axial direction of said extension mandrel, is positioned axially adjacent to insertion slots (any of the sections 22 can be viewed as slots as they are in between raised portions 24) in each case and merges into said slots.

15. With respect to claim 6, Hahnel discloses the device wherein said gripping means (14) are formed by a first and a second pincer (any of the gripping points can be considered "pincers"), each of the first and second pincers comprise fixed jaws (the jaws encircle the mandrel; see figure 1), said jaws having, at their ends, engagement members facing towards one another.

16. With respect to claim 7, Hahnel discloses the device wherein said engagement members engage with at least one recess (flat portion 22 on mandrel 18; see figure 2) within said half mandrel corresponding to said bearing.

17. With respect to claim 8, Hahnel discloses the device wherein said fixing means (16) connected to said gripping means comprises at least one force-actuated detent (contact point is considered a detent as it holds the bearing cap in place).

18. With respect to claim 10, Hahnel discloses the device wherein the engine case comprises a crankshaft case for a reciprocating piston engine. The workpiece (housing block 2 is the engine case and has the crankshaft case which is for a piston engine).

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***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

21. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hahnel in view of any of Hahnel et al. (US 6,457,621), Hase (US 2002/0023939), or Knoll et al. (US 2002/0104864; as cited in IDS).

Hahnel discloses the device of claim 8 but does not specifically disclose the setup of the gripping means (it is noted that Hahnel does not disclose a view looking through the bearing caps so it is hard to tell what the structure of the gripping means actually comprises). Hahnel does disclose the gripping means being a detent acting upon said bearing cap, but does not disclose at least two detents being spaced apart from one another, said detents acting upon said bearing cap at the side which is opposite said corresponding half-mandrel. Examiner notes that in the case of bearing cap breakers, the gripping means typically comprises two detents to secure the top of

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the bearing cap prior to breaking. The prior art references of Knoll et al. (figure 2), Hase (figures 1 and 5), and Hahnel et al. (figure 1) all disclose the claimed setup of the gripping means in relation to a bearing cap. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the device of Hahnel to have the gripper means comprise two detents per bearing case in view of the device of Knoll et al., Hase, or Hahnel et al. in order to grip the top of the bearing case. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art of Henzler et al., Beggs, and Miessen et al. are noted as considered pertinent to the applicant's disclosure. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH DEFRANK whose telephone number is (571)270-3512. The examiner can normally be reached on Monday - Thursday; 9am-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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